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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,748

12/05/2003

Naoki Shimoyama

VTN 601 DIV

3189

27777 7590 01/11/2007
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EXAMINER

BASHORE, ALAIN L

ART UNIT

PAPER NUMBER

1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary**Application No.**

10/729,748

Applicant(s)

SHIMOYAMA ET AL.

Examiner

Alain L. Bashore

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-14,39-49 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14,39-49 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 12-11-06, with respect to the rejection(s) of claim(s) under 35 USC 102 and 103 only have been fully considered and are persuasive. Therefore, the finality of that action has been withdrawn and the after-final amendment dated 12-11-06 has been entered.

However, upon further consideration, a new ground(s) of rejection is made in view of the newly applied art and the indicated allowability of claims is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1, 3-8, 10-14, 39-49, 51-53 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. [note: All claims are

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added to this rejection merely because of their dependency from claim 1. No change has occurred in the 35 U.S.C. 112, first paragraph rejection grounds].

The recitations of: "free of coupling agents" and "the step of immersing is prior to any pretreatment" are both considered negative limitations. These limitations do not appear to be explicitly disclosed in applicant's specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-5, 7, 10,13-14, 39-49, 51-53 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McGee et al.

Note: McGee et al is a divisional of an earlier patented case with a filing date of April 3, 2000.

McGee et al appears to anticipate a method for surface treatment of a plastic article. A step of immersing in an aqueous solution, free of coupling agents and comprising as a first polymer a carboxyl functional polymer having a weight average molecular weight of 200 or more, wherein the step of immersing is prior to any pretreatment, and further immersing the plastic article in an aqueous solution of a second polymer having a weight average molecular weight of 200 or more (para 0068, 0070, 0072, 0112). The article maybe a hydrogel, silicon, or may be a non-hydrogel (i.e. not containing water) (para 0003), also further the water content my be greater than 15% (para 0152). Molecular weights are given (para 0069). Washing and autoclaving is disclosed (para 0152 and 0153). Dynamic contact angle is disclosed (para 0180). The various chemicals are disclosed (para 0079).

While there is maintained that the reference anticipates all the claims, there may be interpretation regarding the negative limitations claimed in calim 1. In the alternative, it would have been obvious to one with ordinary skill in the art to include the claimed negative limitations because there is no mention of a coupling agent, or pretreatment before first step of immersing.

With regards to specific chemical compounds claimed, in the alternative interpretation, any variation would be obvious to one with ordinary skill in the art as known analogs in absence of criticality of results.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al as applied to claims above in the alternative 35 USC 103 rejection, and further in view of Masuhara et al.

McGee et al does not disclose claim 6.

Masuhara discloses claim 6 (col 5, lines 54-67).

It would have been obvious to one with ordinary skill in the art to include claim 6 because Masuhara teaches cornea oxygen requirements (col 5, lines 54-56).

8. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al as applied to claims above in the alternative 35 USC 103 rejection, and further in view of Heiler et al.

McGee et al does not disclose claims 8 or 11.

Heiler et al discloses claims 8 and 11 (col 5, lines 50-60).

It would have been obvious to one with ordinary skill in the art to include claims 8 and 11 because Heiler teaches hydrogel treatment requirement (col 5, lines 54).

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al as applied to claims above in the alternative 35 USC 103 rejection, and further in view of Winterton et al (US patent 6,451,871).

McGee et al does not disclose claim 12.

Winterton ('871) discloses claim 12 (col 2, lines 1-3).

It would have been obvious to one with ordinary skill in the art to include claim 12 because Winterton et al teaches surface treatment technology for contact lenses (col 1, lines 12-34).

Conclusion

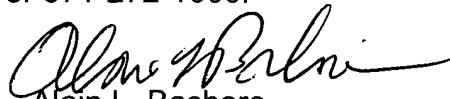
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alain L. Bashore
Primary Examiner
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